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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/378,533	08/20/1999	PAMELA L. MCKISSICK	UV-98	9255
7590 PEJMAN SHARIFI FISH & NEAVE 1251 AVENUE OF THE AMERICAS NEW YORK, NY 100201104			EXAMINER KOENIG, ANDREW Y	
			ART UNIT 2623	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			01/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/378,533

Applicant(s)

MCKISSICK ET AL.

Examiner

Andrew Y. Koenig

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 63-86 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 63-86 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 63-86 have been considered but are moot in view of the new ground(s) of rejection.

The examiner notes that the grounds of rejection has changed in that the applicant has amended to add a new limitation, but does not overcome Knudson of record.

Specifically, the applicant argues that the instant invention improves Knudson by in that it "display[s] information with the at least one program title, wherein the information informs the user" of the fact that the unscheduled program is non-frame. The applicant relies the language of "Coming to PPV," "New This Fall," and "The New Season," see figure 10. The examiner notes that this language is captured as, "the information informs the user that the unscheduled program is outside the program listings time frame that is currently available to the user." Upon further review of Knudson, Knudson teaches different language than relied upon by the applicant, but still performs the claim limitation of information that informs the user that the unscheduled program is outside the program listings time frame that is currently available to the user. For example, Knudson teaches different program types (see figure 7, label 108), which lists types of programs from "first-run," "rerun," "all," "network," and "unviewed only." The examiner notes that by selecting "all," it informs the user that all unscheduled programs outside the program listing time frame that is currently available to the user

will generate a reminder. Whereas it is recognized that if a program is within the current time frame, a notification will be generated, however this interpretation is not precluded in the claim. Consequently, the applicant's argument is not persuasive.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 69-76 and 82-86 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding independent claims 69 and 82, the preamble recites, "A program guide system," which appears to be an apparatus claim. However, the limitations recite steps, such as used in a method claim. Consequently, it is unclear whether the applicant intends to be claiming structure or methods, since the preamble and limitations are inconsistent.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 63-64, 66-72, and 74-86 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication 2005/0204388 to Knudson et al. (Knudson).

It appears that the applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claims 63, 69, 77, and 82, Knudson teaches reminder list displaying at a list of at least one program title (such as "This week with Sam + Cokie") wherein each of the at least one program title is to an unscheduled program that is outside a program listings time frame that is currently available to a user, in that Knudson teaches a list of reminders (figure 10), wherein program titles correspond to series (pg. 5, para. 0058), wherein This week with Sam + Cokie corresponds to programs outside of the program listings time frame in that the system will remind the user of the program (when the program is no part of the program listing time frame) (see pg. 6, para. 0072, 0074).

Knudson teaches program type options for a series recording, which reads on displaying information with the at least one program title (pg. 5, para. 0064, fig. 7, label

108), wherein the information informs the user that the unscheduled program is outside the program listings time frame that is currently available to the user.

In addition, Knudson teaches providing the user with the opportunity to select a program title from the displayed list (fig. 10a, pg. 7, para. 0078), and providing a notification to the user of the availability of the program corresponding to the selected program title when the corresponding program is now in the current program listings time frame (fig. 9, pg. 6, para. 0068).

Knudson teaches informing the user that the unscheduled program is expected to be available at a later time. Knudson teaches different program types (see figure 7, label 108), which lists types of programs from "first-run," "rerun," "all," "network," and "unviewed only." The examiner notes that by selecting "all," it informs the user that all unscheduled programs outside the program listing time frame that is currently available to the user will generate a reminder.

Regarding claims 64, 72, 78, and 83, Knudson teaches displaying a list of programs for which a notification is to be provided (as shown in figure 10).

Regarding claims 66, 74, 79, and 84, Knudson teaches providing a message notification, as shown in figure 9, pg. 6, para. 0068).

Regarding claims 67, 75, 80, and 85, Knudson teaches providing a reminder notification, as shown in figure 9, pg. 6, para. 0068).

Regarding claims 68, 76, 81, and 86, Knudson teaches providing the user with the opportunity to setup a configuration of the notification (fig. 7-8, 10a, 11).

Regarding claim 70, Knudson teaches user television equipment (pg. 3, para. 0043).

Regarding claim 71, Knudson teaches that the equipment can be a personal computer (pg. 3-4, para. 0047).

6. Claims 65 and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication 2005/0204388 to Knudson et al. (Knudson) in view of U.S. Patent Publication No. US 2002/0026496 to Boyer et al. (Boyer).

Regarding claims 65 and 73, Knudson is silent on notifying the user with electronic mail.

Boyer teaches notifying the user with electronic mail; Boyer, in the same field of endeavor, teaches a television programming system with electronic mail notifications of desired programming (page 1, paragraph 6, paragraph 9; see also page 4, paragraph 51) for the advantage of delivering notifications of programming selections to any internet accessible system.

One of ordinary skill in the art would recognize the benefit of notifying the user with electronic mail in order to deliver notifications of programming selections to any Internet accessible system

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Lawler to include presenting comprising notifying said user with electronic mail, as taught by Boyer, for the advantage of delivering notifications of programming selections to any Internet accessible system.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

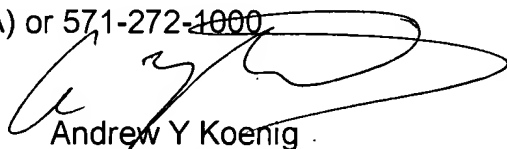
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Y. Koenig whose telephone number is (571) 272-7296. The examiner can normally be reached on M-Fr (8:30 - 5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571)272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Andrew Y Koenig  
Primary Examiner  
Art Unit 2623

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